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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,269	03/05/2002	Tadahiro Ohmi	FUK-84	2418
22855	7590	08/27/2004	EXAMINER	
RANDALL J. KNUTH P.C. 3510-A STELLHORN ROAD FORT WAYNE, IN 46815-4631			CHEVALIER, ALICIA ANN	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/889,269

Applicant(s)

OHMI ET AL.

Examiner

Alicia Chevalier

Art Unit

1772

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 09 August 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1 and 2.

Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

### Continuation Sheet

Continuation of 5. because: It remains the Examiner's position that the claims are unpatentable for reasons previously of record in the final office action, mailed February 9, 2004.

#### *Response to Applicant's Arguments*

1. Applicant's arguments in August 9, 2004 regarding the 35 U.S.C. 102 rejection over Ohmi (U.S. Patent No. 5,656,099) of record have been carefully considered but are deemed unpersuasive.

Applicant argues that Ohmi neither teaches nor suggest a passivation film for a metallic material that employs an oxidized chromium coat on the metallic material.

The Examiner respectfully disagrees with Applicant and maintains that Ohim does teach an oxidized chromium coat on a metallic material as described in the passage in column 2, lines 33-45:

"Another object of the present invention is to provide a method of forming an oxide passivation film having a layer consisting of a **chromium oxide**, which layer enables the formation of a passivation film consisting only of chromium oxide and having a thickness of 20 angstrom or more at the surface thereof.

The present invention is characterized in that a **stainless steel** having excellent corrosion resistance has an oxide passivation film consisting mainly of chromium oxide with a thickness of at least 20 .ANG. (angstrom) on the outermost surface thereof."

Furthermore, s chromium oxide layer is an oxidized chromium coat and stainless steel is a metallic material.

Applicant further argues that Ohmi does not disclose that the passivation film is obtained by oxidizing a chromium coat on the metallic material. Applicant further argues that one

Art Unit: 1772

advantaged realized by the use of a such chromium coating of the invention is the integrity, purity, homogeneity, and geometry of the chromium structure is much more readily controlled since the chromium is integrated with the metallic material as a coating.

First, method limitations do not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents *evidence* from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Ohmi does disclose an oxidized chromium coat on the metallic material (*column 2, lines 33-45*).

Second, there are no limitations in the claim directed to the integrity, purity, homogeneity, and geometry of the chromium structure of the chromium oxide layer. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable.

Third, Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art. The arguments of counsel cannot take the place of *evidence* in the record. See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration. MPEP 2145.

2. Applicant's arguments in August 9, 2004 regarding the 35 U.S.C. 103 rejection over Uchida (U.S. Patent No. 4,248,676) in view of Ohmi of record have been carefully considered but are deemed unpersuasive.

Applicant further argues that Uchida does not disclose that the passivation film is obtained by oxidizing a chromium coat on the metallic material.

Method limitations do not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents *evidence* from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Uchida does disclose an oxidized chromium coat on the metallic material (*col. 3, lines 28-56 and col. 6, lines 14-29*).

### ***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Application/Control Number: 09/889,269

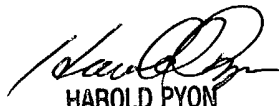
Page 5

Art Unit: 1772

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac

8/20/04

A handwritten signature in black ink, appearing to be 'NR' or similar, written over the date 8/20/04.A handwritten signature in black ink, appearing to be 'Harold Pyon', written over the printed name and title.

HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

8/20/04